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| 10/541,539 | 09/16/2005 | Shiro Torizuka | 2005-1091A | 1477 |
| 513 7590 09/11/2009 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503 | | | | |
| EXAMINER YANG, JIE | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1793 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,539

Applicant(s)

TORIZUKA ET AL.

Examiner

JIE YANG

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/19/2009 has been entered.

Status of the Claims

Claims 1, 6, 17-20 are amended; claims 1-20 are pending in application, and claim 1 is an independent claim.

Status of the Previous Rejection

The previous rejections of claims 1-10 and 13-20 under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al (JP 09-279233 with machine translation, thereafter JP'233) is withdrawn in view of the amendment filed on 5/26/2009.

The previous rejections of claim 11 under 35 U.S.C. 103(a) as being unpatentable over JP'233 in view of Sakata et al (JP 2001-214214, thereafter JP'214) is withdrawn in view of the amendment filed on 5/26/2009.

The previous rejections of claim 12 under 35 U.S.C. 103(a) as being unpatentable over JP'233 in view of Saito (JP 60-200915, thereafter JP'915) is withdrawn in view of the amendment filed on 5/26/2009.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-20 of copending application No. 10/557416.

Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending application No. 10/557416. Although the conflicting claims are not identical, they are not patentably distinct from each other because both comprise a warm rolling method for manufacturing a steel

material having a grain size of 3 micrometers or less, which comprises rolling of one pass or more in a temperature range of 350 to 800°C. Regarding the newly added features of continuous multipass rolling at a rolling temperature range of 350°C to 800°C in the instant claim 1, claim 11 of copending application No. 10/557416 discloses the same parameter Z formula as recited in the instant claim; claim 1 of copending application No. 10/557416 discloses the same warm rolling temperature range of 350°C to 800°C as recited in the instant claim; and claims 19 and 20 of copending application No. 10/557416 discloses same continuous multipass rolling as recited in the instant claim. Regarding the amended feature of at least one pass interval is longer than 20 seconds in the instant claim 1, claim 11 of copending application No. 10/557416 discloses the same parameter Z formula and the same relationship between the Z and the microstructures of the material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select proper pass interval according the Z formula and the desired microstructure as disclosed in claims 1-20 of copending application No. 10/557416 in order to obtain desired warm rolling results. Claims 1 and 14 of copending application No. 10/557416 discloses ultrafine grain size after

warm rolling, which reads on the ultrafine grain size as recited in the amended instant claims 6 and 17-20.

This is a provisional obviousness-type double patenting rejection because the conflict claims have not in fact been patented.

Response to Arguments

Regarding the Double Patenting Rejection, the Applicant intends to file a Terminal Disclaimer in Applicant arguments/remarks filed on 5/26/2009 and the Examiner made a phone call to the Attorney (Amy E. Schmid) on Aug. 18, 2009 to require the Terminal Disclaimer but did not result in receiving a proper Terminal Disclaimer from the Applicant before this office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jie Yang whose telephone number is 571-2701884. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-2721244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JY

/Roy King/
Supervisory Patent Examiner, Art Unit 1793